

## REMARKS

### 1. Summary of Office Action

In the Office Action mailed March 2, 2005, the Examiner objected to an informality of claims 18 and 19. The Examiner rejected claims 1-6, 8, 9, 11-12, 16, and 18-19 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,946,320 (Decker) in view of the Applicants' Admitted Prior Art (hereinafter "AAPA"). The Examiner rejected claims 7 and 10 under 35 U.S.C. §103(a) as being unpatentable over Decker in view of the AAPA, and further in view of U.S. Patent No. 6,646,993 (Davies et al.). The Examiner rejected claims 13-15, 17, and 20 under 35 U.S.C. §103(a) as being unpatentable over Decker in view of Davies et al.

### 2. Amendments and Pending Claims

Applicants have amended claims 1, 7, 13, and 16-19. Now pending in this application are claims 1-20 of which claims 1, 13, 16, and 17 are independent.

### 3. Request for Reconsideration of Making Office Action Final

M.P.E.P. §706.07(a) provides that second or any subsequent actions on the merit shall be final, except where the Examiner introduces a *new ground of rejection* that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement during the period set forth in 37 C.F.R. 1.97(c). (Emphasis added).

In the previous Office Action (mailed July 14, 2004), as well as in the current Office Action (mailed March 2, 2005), in rejecting claims 1, 13, 16, and 17 under 35 U.S.C. §103(a), the Examiner indicated that Decker teaches the claim limitation of in response to an ACK signal from the reception side representing that normal data has been received, clearing at the

transmission side the retransmitted data from a second storage unit, and the Examiner cited to Col. 2, lines 6-11 in support.

In the Applicants' response (filed December 17, 2004) to the previous Office Action, the Applicants indicated that (i) the combination of Decker and the AAPA fails to teach in response to an ACK signal from the reception side representing that normal data has been received, clearing at the *transmission side* the retransmitted data from a second storage unit, as recited in claims 1 and 16, and (ii) the combination of Decker and Davies et al. fails to teach in response to an ACK signal from the reception side representing that normal data has been received, clearing the retransmitted data from a second storage unit at the *transmission side*, as recited in claims 13 and 17. (Emphasis added).

In addressing the Applicants' response filed December 17, 2004, the Examiner indicated for the first time that it is *implicit* in the teachings of Decker that data stored in the second storage unit at the transmission side is cleared. (Emphasis added). The Examiner also indicated that this *implicit process* (414) is explained more clearly in related art, namely, U.S. Patent No. 6,173,431 (Rittle) (Col. 8, lines 22-42). (Emphasis added). According to M.P.E.P. §706.02(j), "[w]here a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection." In the previous Office Action, Rittle was not positively included in the statement of rejection of claims 1, 13, 16, and 17

Moreover, according to M.P.E.P. §2112, "In relying upon the theory of inherency, the examiner *must* provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." (Emphasis added). In the previous Office Action, the Examiner did not allege any inherent teaching of Decker in rejecting independent claims 1, 13, 16, and 17, nor did

the Examiner provide the required basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Decker.

Because the Examiner alleges an implicit teaching of Decker to reject claims 1, 13, 16, and 17 in the current Office Action, whereas in the previous Office Action the Examiner did not allege this implicit teaching of Decker or provide the required basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of Decker, and because the Examiner used Rittle for the first time in the current Office Action to reject claims 1, 13, 16, and 17, the Applicants submit that the Examiner has introduced a new ground of rejection for claims 1, 13, 16, and 17. This new ground of rejection was neither necessitated by any claim amendments (claims 1, 13, 16, and 17 were not amended at all) nor based on information submitted in an information disclosure statement. Accordingly, the Applicants respectfully request reconsideration of making this Office Action Final and request withdrawal of the finality of this Office Action.

#### **4. Response to Claim Objections**

The Examiner objected to an informality of claims 18 and 19. Applicants have amended claims 18 and 19 as suggested by the Examiner. Applicants submit that claims 18 and 19 are in a condition for allowance.

#### **5. Response to §103 Rejections**

The Examiner rejected (i) claims 1-6, 8, 9, 11-12, 16, and 18-19 under 35 U.S.C. §103(a) as being unpatentable over Decker in view of the AAPA, (ii) claims 13-15, 17, and 20 under 35 U.S.C. §103(a) as being unpatentable over Decker in view of Davies et al., and (iii) claims 7 and 10 under 35 U.S.C. §103(a) as being unpatentable over Decker in view of the AAPA, and further

in view of Davies et al. Applicants respectfully traverse the rejection of claims 1-20 because the combination of Decker, Davies et al. and the AAPA fails to disclose or suggest the combination of elements recited in any of these claims, as amended.

Claims 1, 13, 16, and 17 were amended to include a limitation from claim 7, which the Examiner has already examined. With respect to these amended claims, the combination of Decker, Davies et al., and the AAPA fails to disclose or suggest (i) transmitting to the reception side first information related to retransmission and *then* retransmitting the requested data, wherein the first information includes information about *when the transmission side will retransmit the requested data* to the reception side, as recited in amended claims 1 and 16, or (ii) transmitting to the reception side information about *when the transmission side will retransmit the requested data* to the reception side, and *then* retransmitting to the reception side the requested data and a TFCI, as recited in amended claims 13 and 17. (Emphasis added).

In rejecting claim 7, the Examiner indicated that Decker and the AAPA fail to expressly disclose the information including *when the data will be retransmitted*. (Emphasis added). The Examiner indicated that including information such as when data will be transmitted before the data is sent to the reception side was well known in the art at the time of the present invention. In support, the Examiner indicated that Davies et al. (Col. 2, lines 26-25) teaches receiving first information that is used to perform appropriate decoding of data, such as how the transmission side established a coding rate and a puncturing.

At best, this section of Davies et al. merely teaches that (i) *information on the transmission format* will be embedded in the communication, (ii) control bits known as TFCI bits will be included to signal the receiving units of the format used to encode user data, and (iii) parameters that may be affected by the TFCI include spreading factor or modulation, channel

coding, rate matching, interleaving and service multiplexing. (Emphasis added). However, this particular section of Davies et al., as well as the rest of Davies et al., Decker, and the AAPA, do not teach or suggest information about when the transmission side will retransmit requested data to a reception side, as recited in amended claims 1, 13, 16, and 17.

Moreover, Davies et al. teaches that the TFCI bits are transmitted on one quadrature channel while the user data is transmitted *simultaneously* on the other quadrature channel. (Col. 2, lines 36-38). (Emphasis added). Thus, even if the TFCI bits are somehow considered to be first information that includes information about when the transmission side will retransmit the requested data to the reception side, this section of Davies et al. does not teach (i) transmitting to the reception side first information related to retransmission, and *then* retransmitting the requested data, as recited in amended claims 1 and 16, or (ii) transmitting to the reception side information about when the transmission side will retransmit the requested data to the reception side, and *then* retransmitting to the reception side the requested data and a TFCI, as recited in amended claims 13 and 17. (Emphasis added).

Although Davies et al. teaches “[i]f the received transmission format information ... belongs to the second subset it will relate to the transmission format of the following transmission block” and “transmission format changes which have an impact on how the channel data symbols are determined will be known in advance to receiving the corresponding transmission block,” Davies et al. does not teach or suggest that the received transmission format information includes information about when the transmission side will retransmit the requested data to the reception side. (See e.g., Col. 5, lines 13-24).

Since the combination of Decker, Davies et al., and the AAPA, do not disclose or suggest the combination of elements in claims 1, 13, 16, and 17, Applicants submit that the combination

of Decker and the AAPA does not disclose or suggest the combination of elements recited in claims 1 and 16, and that the combination of Decker and Davies et al. does not disclose or suggest the combination of elements recited in claims 13 and 17.

For these and potentially other reasons, claims 1, 13, 16, and 17 are allowable over Decker, Davies et al., and the AAPA. Further, claims 2-12, 14-15, and 18-20 depend from either claim 1 or claim 13 and are also allowable over the combination of Decker, Davies et al., and the AAPA for at least the reason they are dependent on an allowable claim.

## **6. Conclusion**

In view of the above amendments and remarks, Applicants respectfully submit that claims 1-20 are now in a condition for allowance, and respectfully request favorable reconsideration and allowance of the claims. If the Examiner would like to discuss this case, the Examiner is encouraged to contact the undersigned at (312) 913-2129.

Respectfully submitted,  
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